

REMARKS

Claims 1-3, 5, 7-19, 21-27, and 54-59 were presented for examination and were finally rejected. Applicants hereby seek to amend claims 8, 11, 14, 15, and 24 pursuant to the provisions of Rule 116. Support for all amendments is found in the application as originally filed. Reconsideration of the application as amended, and allowance of all claims remaining herein, claims 1-3, 5, 7-19, 21-27, and 54-59 as amended, are hereby respectfully requested.

Applicants respectfully submit that the Examiner should enter the offered amendments, because the sole purpose of the instant amendment is to improve the punctuation. Thus, the amendments address solely a matter of form, and no additional search is required. Furthermore, the claims as amended are now in condition for allowance. 37 C.F.R. §1.116; MPEP 714.12, 714.13.

In her second numbered paragraph, the Examiner rejected claims 1, 2, "5-13-19", 21-27, and 54-59 under 35 U.S.C. §102(e) as being anticipated by Lachman, III et al., U.S. patent publication 2002/0166063 A1 (hereinafter "Lachman 2"). Applicants assume that the Examiner meant to reject claims 5 and 7-19 rather than claims "5-13-19".

Lachman 2, filed February 28, 2002, claims priority to U.S. provisional patent application serial no. 60/272,712, filed March 1, 2001 (hereinafter "Lachman 1"). Lachman 2 has a publication date of November 7, 2002, which date is the earliest date by which the public had access to either Lachman 1 or Lachman 2. 35 U.S.C. §122(a).

The filing date of the instant application is October 19, 2001, which date falls between the filing dates of Lachman 1 and Lachman 2, and precedes both the filing date and the

publication date of Lachman 2. Lachman 2, according to the USPTO's PAIR database, has been abandoned since at least June 25, 2007.

The Examiner's position, expressed at numbered paragraph 2 and at page 12 of her final Office Action, is that Lachman 2 is a 35 U.S.C. §102(e) reference that may be used as prior art against the instant application. Applicants traverse this rejection, for at least the following reasons.

I. **LACHMAN 2 IS NOT A LEGITIMATE PRIOR ART REFERENCE.**

A. **The Examiner used the wrong legal standard to determine that subject matter in Lachman 2 is prior art that may be used against the instant application.**

The Examiner stated at page 12 of her final Office Action:

“(a) The provisional application, Lachman I (60/272,712), for which Lachman III [Lachman 2] (US Patent Application Publication 2002/0166063 A1) claims benefit, discloses subject matter which is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application (US Patent Publication 2002/0166063 A1) was filed, had possession of the claimed invention. Therefore, Lachman III [Lachman 2] can be used as prior art against the instant application.” Office Action, p. 12, underlining and matter in brackets added.

The Examiner failed to state which of the two specifications she intended in the underlined phrase “the specification.” This ambiguity is particularly significant, because the disclosures of Lachman 1 and Lachman 2 are significantly different: Lachman 2, having a 16,000 word specification and including 40 Figures, contains mostly new matter relative to Lachman 1, which is only 6,000 words in length and includes only 13 Figures.

As best understood by Applicants, the Examiner is contending that the written description in Lachman 1 demonstrates that the Lachman 2 inventors were in possession, as of the filing date of Lachman 2, of the invention claimed in Lachman 2 and, therefore, Lachman 2 can be used as prior art against the instant application. The Examiner appears to be invoking the rule discussed at MPEP 2163 I. (citing Capon v. Eshhar, 418 F. 3d 1349, 1357 (Fed. Cir. 2005); copy enclosed herewith as Enclosure 9) that an application's written description must be sufficiently clear, concise, and complete to demonstrate that the patentee was in possession of the invention as claimed in the application. The Capon "in possession" rule compares the written description in a patent application with the claims in the same patent application. It does not have anything to do with the point at issue here: comparing the specification of an abandoned utility patent application with the specification of an underlying provisional patent application. As detailed below, meeting the written description requirement is a necessary but far from sufficient condition for Lachman 2 to be used as prior art against the instant application.

For Lachman 2 to be 35 U.S.C. §102(e) prior art to the instant application, one of the criteria is that Lachman 2 be accorded a "critical reference date" as of Lachman 1's filing date. As explained at MPEP 2136.03 III., this means, as a threshold matter, that Lachman 2 must be entitled to the benefit of the filing date of Lachman 1. To be so entitled, Lachman 1 must meet *all of* the requirements of 35 U.S.C. §112, first paragraph, with respect to the claims of Lachman 2, not just the written description requirement. 35 U.S.C. §119(e)(1). Furthermore, Lachman 1 must meet *all of* the requirements of 35 U.S.C. §112, first paragraph, with respect to the subject matter relied upon in making the rejection. MPEP 2136.03 III.

As required by 35 U.S.C. §119(e)(1), in order for Lachman 2 to be entitled to the benefit of Lachman 1's filing date, Lachman 1 must disclose the invention claimed in Lachman 2 "in the manner provided by the first paragraph of section 112". This requirement of §119(e)(1) compels more than a mere showing that the applicants were "in possession of" the invention claimed in Lachman 2 at the time of filing Lachman 2. It requires that Lachman 1 fully comply with the written description, enablement, and best mode requirements of the first paragraph of 35 U.S.C. §112. In her final Office Action, the Examiner failed to even assert that the invention claimed in Lachman 2 is disclosed in Lachman 1 in the manner provided by the first paragraph of §112.

Most of the arguments made by the Examiner in her final rejection pertain to what Lachman 2 discloses. But what Lachman 2 discloses is irrelevant. Even if 35 U.S.C. §102(e) could properly be invoked here (which Applicants vigorously dispute), what would be relevant is what Lachman 1 discloses, not what Lachman 2 discloses.

Even if the claims in Lachman 2 were adequately supported in the written description of Lachman 1, yet more would be required: Lachman 2 may be accorded a 35 U.S.C. §102(e) critical reference date as of Lachman 1's filing date only if, in addition, Lachman 1 properly supports the *subject matter of Lachman 2 relied upon to make the rejection* in compliance with 35 U.S.C. §112, first paragraph. Ex parte Yamaguchi (Appeal 2007-4412 decided by the BPAI on August 24, 2008, at page 18; copy enclosed herewith as enclosure 8); MPEP 2136.03 III. In her final Office Action, the Examiner failed to even assert that the subject matter relied upon in making the rejection (taken from Lachman 2) is properly supported in Lachman 1.

B. It is not proper to invoke 35 U.S.C. §102(e) here.

The Yamaguchi case cited above held, for the specific facts in that case, that a U.S. provisional patent application can serve as a proper 35 U.S.C. §102(e) reference. However, the present case is radically different from the fact scenario in Yamaguchi, because in Yamaguchi, the utility patent application that was based upon the provisional patent application had not been abandoned. In the present case, on the other hand, the Lachman 2 utility patent application has been abandoned. Applicants have not uncovered any case law involving a fact situation in which the utility patent application has been abandoned subsequent to publication. Thus, they will now analyze first principles of law and whatever tangential precedent is available . These basic principles of law lead Applicants to the inexorable conclusion that 35 U.S.C. §102(e) is not available here.

The USPTO examination guidelines, first published in the January 14, 2003 Official Gazette, state:

"The 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any *proper* priority or benefit claims to prior U.S. applications under §119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection." Examination Guidelines for 35 U.S.C. §102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. §102(g), Discussion Section IV(4)(b), emphasis added, copy provided to USPTO previously as Enclosure 1 to Amendment G.

For the reasons detailed hereinbelow, this policy is inadequate to support the Examiner's position that 35 U.S.C. §102(e) may be invoked.

1. Courts have strictly limited the circumstances in which “secret” references are allowed to defeat an Applicant’s patent right.

35 U.S.C. §102(e) provides for a limited exception to the general rule that a prior art reference must be publicly accessible. Prior to the enactment in 1999 of the American Inventors Protection Act (hereinafter, the “AIPA”), 35 U.S.C. §102(e) simply codified the U.S. Supreme Court rule of Alexander Milburn v. Davis-Bournonville, 270 U.S. 390 (1926) in providing that a person shall be entitled to a patent unless (*inter alia*):

“(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent...”.

The rule of Milburn, and §102(e) as it existed prior to the AIPA, was summarized by Judge Giles Rich as follows:

“...a complete description of an invention in a U.S. patent application, filed before the date of invention of another, if it matures into a patent, may be used to show that that other was not the first inventor.” (emphasis added); In re Hilmer, 359 F. 2d 859, 877 (CCPA 1966); hereinafter “Hilmer I”, copy provided to the USPTO previously as Enclosure 2 to Amendment G.

In Milburn, a copy of which was provided to the USPTO as Enclosure 3 to Amendment G, an earlier-filed patent application disclosing the invention claimed in a later-filed patent application did not issue (and was not publicly available) until after the filing date of the later-filed application. The Supreme Court assumed there “would have been no bar to [the later filer’s] patent if [the earlier filer] had written out his prior description and kept it in his portfolio uncommunicated to anyone”. Milburn at 400. But because the first filer “had done all that he could do to make his description public... [and] had taken steps that would make it public as soon as the Patent Office did its work”, the earlier filed application defeated the later filer’s

patent rights, even though it was not publicly available at the time the later application was filed Id at 401. Judge Rich, in another CCPA opinion, summarized the rationale of the Milburn holding as “that ‘but for’ the delays in the Patent Office, the patent would have earlier issued and would have been prior art known to the public.” In re Wertheim and Mishkin, 646 F. 2d 527, 536 (CCPA 1981), copy provided previously to the USPTO as Enclosure 4 to Amendment G.

As widely referred to in numerous subsequent cases, the so-called Milburn Doctrine is an exception to the general rule that prior knowledge must be public in order to defeat another’s patent rights. Ex parte Osmond, 191 U.S.P.Q. (BNA) 334, 337 (USPTO BPAI 1973), copy provided previously to the USPTO as Enclosure 5 to Amendment G. The Milburn Doctrine has been “held to be limited to its own factual situation and that in order to be applicable a patent must issue.” Id.

Here, the relevant facts are inapposite to the Milburn “factual situation”, at least because Lachman 2 never issued, and because the filing of Lachman 1 did not in itself make the disclosure public, since a provisional patent application is not automatically published. The applicant in Lachman 1 merely preserved for twelve months the option of filing a utility patent application claiming the benefit of Lachman 1, while also preserving the opportunity to benefit from the provisions of 35 U.S.C. §122 and avoid disclosing its contents to the public.

2. *Courts have rejected past attempts by the USPTO to “read together” provisions of 35 U.S.C. §102(e) and 35 U.S.C. §119.*

Only by conflating the priority-granting provisions of §119 with the patent-defeating provisions of §102(e) is it possible to conclude that Lachman 2 should be accorded a 102(e)

critical reference date prior to Applicants' filing date. This "reading together" of §119 and §102(e) was strongly criticized by the CCPA's holding in Hilmer I:

"We see no reason for reading these two provisions together and the board has stated none. We believe, with the dissenting board member, that 119 and 102(e) deal with unrelated concepts and further that the historical origins of the two sections show neither was intended to affect the other, wherefore they should not be read together in violation of the most basic rule of statutory construction, the "master rule," of carrying out the legislative intent. Additionally, we have a long and consistent administrative practice in applying an interpretation contrary to the new view of the board, confirmed by legislation ratification in 1952." Hilmer I at 872.

Hilmer I was decided before 35 U.S.C. §119 was amended by adding subsection (e) providing for provisional applications. As discussed below, nothing suggests a legislative intent, when adding subsection (e) to section 119, to overturn Hilmer I by authorizing "reading together" §102(e) and §119(e).

3. Under the USPTO's Board of Patent Appeals and Interferences precedent, Lachman 2 is entitled to an effective date as a reference only as of its publication date, not its filing date, much less the Lachman 1 filing date.

Judge Rich's analysis in Hilmer 1 demonstrated the error in reading §119 and §102(e) together to accord an effective date to a reference that was earlier than the reference's actual U.S. filing date. In light of Board of Patent Appeals and Interferences (BPAI) precedent, Lachman 2, moreover, should not be accorded an effective date earlier than Lachman 2's **publication** date. The BPAI has held that subsequent publication of an abandoned U.S. patent application is not evidence of prior knowledge as of the filing date of such application. Ex parte Osmond at 338. Rather, a disclosure in such an application is evidence of prior knowledge only as of the date by which public access to the disclosure is first provided. Id. There is no policy reason why a U.S.

patent application (e.g., Lachman 2) that is published and then abandoned should have a different prior art effect than a U.S. patent application that was first abandoned, and then published. As stated above, the Yamaguchi decision did not address this question. Here, Lachman 1 and Lachman 2 were first published after Lachman 1's expiration; then Lachman 2 was abandoned after the publication date. Under Ex parte Osmond, the effective date of Lachman 2 is its publication date, not its filing date, because that is the date when public access to the disclosures was first provided.

4. Statutory revisions providing for provisional applications and 18 month publication rules should be construed narrowly in light of Milburn, Hilmer I, and Osmond.

a) The GATT Uruguay Round Agreements Act (hereinafter, the “1994 Act”)

The 1994 Act amended, *inter alia*, 35 U.S.C. §111 and §119 to provide respective subsections §111(b) and §119(e) relating to U.S. provisional patent applications. The 1994 Act did not amend 35 U.S.C. §102(e). Nor was any legislative intent expressed to overturn the case law discussed above.

Nevertheless, according to the USPTO, under the 1994 Act,

“Section 119(e)(1) of title 35, United States Code, provides that if all of the conditions of 35 U.S.C. 119 (e)(1) and (e)(2) are met, an application for patent filed under 35 U.S.C. 111(a) or 363 shall have the same effect as though filed on the date of the provisional application. Thus, the effective United States filing date of an application for patent filed under 35 U.S.C. 111(a), and entitled to benefits under 35 U.S.C. 119(e), is the filing date of the provisional application. Any patent granted on such an application, is prior art under 35 U.S.C. 102(e) as of the filing date of the provisional application.” 60 FR 20195, 20197 (1995), emphasis added, copy provided to the USPTO previously as Enclosure 6 to Amendment G.

This interpretation of the legal effects of the 1994 Act, provided in the “Supplemental Information” section of the Federal Register dated April 25, 1995 entitled “Changes to Implement 20-Year Patent Term and Provisional Applications”, is noteworthy in two respects. First, the interpretation fails to cite a legal authority, or make reference to stated legislative intent, for directly contravening Hilmer I by “reading together” provisions of Section §119 and §102(e). Second, the USPTO’s interpretation of the 1994 Act provides only that a “*patent granted* on such an application, is prior art under 35 U.S.C. 102(e) as of the filing date of the provisional application.” The statement provides no authority for the present Office Action, which rejects claims on the basis of an *abandoned* patent *application*.

As to the first point, it must be presumed that Congress, when adapting the 1994 Act, was aware of Hilmer I, and the respective legislative histories of 35 U.S.C. §119 and §120. Prior to 1994, §119 addressed only foreign priority, whereas §120 dealt with domestic priority. Although §120 and §119 employ an identical phrase, “shall have the same effect, as to such invention”, the court in Hilmer I, after a painstaking analysis of the legislative history of each section, dismissed the use of the same expression as “mere happenstance”. Hilmer I at 879. Furthermore, Hilmer I specifically disapproved of the USPTO’s position that the expression “shall have the same effect, as to such invention” should have the same meaning with respect to §120 domestic priority as to §119 foreign priority. In adapting the 1994 Act, Congress chose to modify §119, not §120, even though provisional applications, as domestic filings, might more logically be related to the latter section. As at least one commentator has observed, however:

“Provisional applications have in common with foreign priority applications a feature not shared by regular §111(a) applications: provisional applications, like foreign priority applications, can never become a U.S. patent.” Patch, Andrew J.,

Provisional Applications and 35 U.S.C. 102(e) in View of Milburn, Hilmer and Wertheim, 77 J. Pat. & Trademark Off. Soc'y 339, 346 (1995), copy provided to the USPTO previously as Enclosure 7 to Amendment G.

In light of the foregoing, and in the absence of evident legislative intent to the contrary, the USPTO's interpretation of the 1994 Act at 60 FR 20195, 20197 (which was not implemented by way of any amendment to CFR Title 37) is untenable.

In addition, as noted above, the USPTO pronouncement addressed only the prior art effect of an *issued patent* claiming priority to a provisional application, notwithstanding public comments relating to a broader question:

“13. Comment: Several comments requested that the PTO clarify whether a 35 U.S.C. 111(a) application will be accorded an effective date as a reference under 35 U.S.C. 102(e) as of the filing date of the provisional application for which benefit under 35 U.S.C. 119(e) is claimed...

Response: If a patent is granted on a 35 U.S.C. 111(a) application claiming the benefit of the filing date of a provisional application, the filing date of the provisional application will be the 35 U.S.C. 102(e) prior art date. A pending application will be rejected under 35 U.S.C. 102(e) on the basis that an invention was described in a patent granted on a 35 U.S.C. 111(a) application which claimed the benefit of the filing date of a provisional application by another filed in the U.S. before the invention thereof by the applicant for patent.” 60 FR 20195, 20206 (1995), emphasis added.

Although the comment requested clarification as to the effective date as a 102(e) reference of an *application* claiming the benefit of the filing date of a U.S. provisional patent application, the response provided the USPTO's position as to the effective date if a *patent* were granted on such nonprovisional application. It appears that the USPTO was cognizant, at least in 1995, that there was no authority for according a pending--not to mention an abandoned--patent application an effective date as a reference as of the filing date of the provisional application for

which benefit under 35 U.S.C. §119(e) is claimed. Nothing in the 1994 Act suggested an intention to thus overrule the Milburn doctrine. Consistent with that doctrine, where a reference is an unissued *abandoned* patent application, the effective date of that reference can only be the date at which the application became publicly accessible.

b) The AIPA

The 1999 AIPA amended, *inter alia*, 35 U.S.C. §102(e) to provide for eighteen-month publication of some patent applications. 35 U.S.C. §102(e) was amended to provide, in relevant part, that a person shall be entitled to a patent unless (*inter alia*):

“(e) the invention was described in -- (1) an application for patent, published under section 122(b) [35 U.S.C. §122(b)], by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent...”.

To implement provisions of the AIPA and related technical amendments to §102(e), the USPTO promulgated examination guidelines signed December 11, 2002 published in the Official Gazette on January 14, 2003 (the “Guidelines”). In Discussion Section IV(4)(b) of the Guidelines, the USPTO advised:

The 102(e) date of a reference ... is its earliest effective U.S. filing date, taking into consideration any proper priority or benefit claims to prior U.S. applications under 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection.

As discussed above, the Examiner has failed to even allege that Lachman 1 properly supports the subject matter (found in Lachman 2) used to make her rejection. Even assuming, *arguendo*, that the Examiner’s rejections somehow complied with the Guidelines quoted above,

the rejection is still flawed, because the Guidelines themselves, which do not have the force of law, improperly construe the statutory language of §102(e) and §119(e) in derogation of the common law discussed above.

The Guidelines provide no authority for the proposition that §102(e) can be read together with §119(e) in contravention of Hilmer I. If the two provisions are not so conflated, Lachman 2 cannot be accorded an effective date as a 102(e) reference earlier than its own filing date. Indeed, under Osmond, Lachman 2 cannot be properly accorded an effective date earlier than Lachman 2's *publication* date.

c) The legal impact of Lachman 2's abandonment

The Examiner provided no authority -- and Applicants are aware of none -- for her assumption that published patent applications, once abandoned, could ever be proper §102(e) references, regardless of the existence of an underlying provisional application. Treating abandoned patent applications as §102(e) references produces the anomalous result that an application published after abandonment has an effective date as a reference as of its publication date (Osmond, supra), but that an application abandoned after publication has an effective date as of its filing date. To avoid this anomaly, absent expressed legislative intent to the contrary, the language of 35 U.S.C. §102(e), “application for patent, published under section 122(b)” must be construed as not encompassing abandoned patent applications. Applicants therefore conclude that Lachman 2 is not a proper 35 U.S.C. §102(e) reference, but, rather, only a 35 U.S.C. §102(a) or §102(b) reference having an effective date as of its publication date (November 7, 2002). As a result, the Examiner has failed to establish a *prima facie* case of anticipation.

II. LACHMAN 1 FAILS TO ANTICIPATE OR SUGGEST APPLICANTS' CLAIMED INVENTION.

Even assuming, *arguendo*, that the disclosure of Lachman 1 may somehow properly be used as prior art against the instant application, Applicants' claims, for the reasons detailed below, are still allowable, because the disclosure of Lachman 1 fails to teach, or even suggest, the instant invention as presently claimed.

A. Claim 1, as amended, recites that a content portion of a data packet transiting a network access point is inspected by a data enabling device (DED) containing content match information; an inspected data packet is forwarded when information within the content portion of a data packet is not substantially similar to content match information; and when information within the content portion of a data packet is substantially similar to content match information, the inspected data packet is temporarily stored while the DED initiates issuance of a message to a user workstation, and invokes a regional transaction processor (RTP) to process a transaction, where the RTP authorizes forwarding of the data packet only when the transaction result indicates that said forwarding is appropriate.

Lachman 1 discloses techniques for passively detecting “denial of service” attacks and for providing countermeasures to such attacks. Lachman 1, page 4, lines 4-6. As described in Lachman 1, data packets are screened by a packet sniffer, which compares incoming packets to a stored signature database, the signature database being derived from common denial of service attack patterns. Following receipt of a “suspicious” packet, the source address of the suspicious packet may be traced, and defensive measures put in place to protect a host computer network from further attacks from that source.

Lachman 1 fails to disclose inspecting at least the content portions of data packets transiting a network access point, where each data packet has a content portion, a header, and a trailer.

Lachman 1 discloses that “packets are compared to a stored signature database” in the packet sniffing portion of the method (page 5 line 4), but is vague as to the definition of “signature”. In all of the examples in Lachman 1 that are relevant to the locations within the packets where the comparisons are performed, Lachman 1 discloses that the comparisons are performed in the header portions of the packets, as to opposed content portions. Lachman 1, page 6 line 20, page 10 lines 20-22, page 11 line 5, page 12 line 4, page 13 line 16, page 13 line 21, page 14 line 4, page 14 line 19, and page 16 lines 22-23. This is not surprising, given that the purpose of Lachman 1 is to thwart denial of service attacks (Lachman 1, page 4 line 5). Indeed, the word “content” is used only once in the sixty-four paragraph disclosure of Lachman 1 (at page 4 line 19), and the word “payload” (synonymous with “content portion of a packet”) is not used anywhere.

Even assuming, *arguendo*, that Lachman 1 somehow suggests inspecting the content portion of a data packet, Lachman 1 specifically teaches away from inspecting packets *transiting a network access point*. According to Lachman 1, their A.N.T. system “sits between the host router and the main server on a protected network.” Lachman 1, page 11, lines 11-12. As such, their A.N.T. system is not disposed at a network access point, and is thus incapable of inspecting packets transiting a network access point. Compare Lachman 1, Figure 1 with Figure 1 of the instant application.

Lachman 1 fails to suggest that when information within the content portion of a data packet is substantially similar to content match information, a DED, disposed at a network access point, initiates issuance of a message to a user workstation and invokes an RTP to process a transaction, whereupon the RTP instructs the DED to forward or prevent forwarding the data packet based on a result of the transaction. Applicants respectfully request the Examiner to state which item of Lachman I she believes suggests Applicants' RTP.

B. Claims 2, 5, 7-17, and 54-59 depend from claim 1, and thus their patentability flows from the patentability of claim 1. Furthermore, these dependent claims as amended include additional features that distinguish them from the prior art.

C. Claim 18 as amended contains substantially the same limitations that are recited in amended claim 1. Therefore, the arguments submitted above in favor of the patentability of claim 1 also pertain to the patentability of claim 18, mutatis mutandis.

D. Claims 19 and 21-27 are dependent claims depending upon claim 18. Therefore, their patentability flows from the patentability of claim 18. Furthermore, these dependent claims as amended contain additional limitations not suggested by the prior art.

For the above reasons, Applicants hereby request the Examiner to withdraw her rejection of claims 1, 2, 5, 7-19, 21-27, and 54-59; and to allow these claims as amended.

In her fourth numbered paragraph, the Examiner rejected claim 3 under 35 U.S.C. §103(a) as being unpatentable over Lachman 2 in view of May. Claim 3 is a dependent claim depending upon claim 1. As demonstrated above, a *prima facie* case of anticipation with respect to claim 1 based upon Lachman 2 has not been established. The addition of May to the rejection

adds nothing to counter the patentability of claim 1. Therefore, it follows that claim 3 is patentable.

For the above reasons, Applicants hereby request the Examiner to withdraw her §103(a) rejection of claim 3, and to allow claim 3 as amended.

Applicants believe that this application is now in condition for allowance of all claims remaining herein, claims 1-3, 5, 7-19, 21-27, and 54-59 as amended, and therefore an early Notice of Allowance is respectfully requested. In the alternative, Applicants hereby request that the Examiner enter the proffered amendments, to facilitate an appeal. If the Examiner believes that, for any reason, direct contact with Applicants' attorney would help advance the prosecution of this case to finality, she is invited to telephone the undersigned at the number given below, for purposes of arranging for a telephonic interview. Such an interview would be considered to be an Applicant-initiated interview.

Respectfully submitted,

date of signature:

Dec-18, 2008

Edward J. Radlo
Attorney of Record
Reg. No. 26,793



SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
tel.: (415) 882-2402

enclosures

cc: IP/T docket CH (w. encl)
G. Benton (")(Kulig)

27308982\W-1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Matthew P. Kulig, Timmy L. Brooks, John W. Lockwood, and David Kyle Reddick

Application No.: 10/037,593

Filing Date: October 19, 2001

Title: SYSTEM AND METHOD FOR CONTROLLING TRANSMISSION OF DATA PACKETS OVER AN INFORMATION NETWORK

Confirmation No.: 6376

Group Art Unit: 2157

Examiner: Barbara N. Burgess

Attorney Docket No.: 60022210-0157

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

INFORMATION DISCLOSURE

STATEMENT

SONNENSCHEIN NATH & ROSENTHAL LLP
Customer No. 26263

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date given below.

Dec 18, 2008

date of signature

Edward Radlo
Edward J. Radlo, Reg. No. 26,793

Sir:

Pursuant to the provisions of 37 CFR § 1.56 and § 1.97-§1.98, Applicants hereby submit one patent reference which they believe may be material to the examination of this application and in respect of which there may be a duty to disclose.

This reference is set forth on the attached Substitute Form PTO 1449. A copy of the listed reference is not provided, because it is an issued United States patent. The undersigned became aware of the listed reference via an Office Action that was mailed by the USPTO on December 2, 2008 in a related patent application.

While the reference disclosed in this Information Disclosure Statement may be "material" pursuant to 37 CFR § 1.56, submission of this IDS is not intended to constitute an admission that said reference is "prior art" for this invention.

In accordance with 37 CFR § 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR § 1.56(a) exists. It is submitted that this Information Disclosure Statement

complies with 37 CFR § 1.98 and MPEP § 609, and the Examiner is respectfully requested to consider the listed reference.

This IDS is being submitted after the mailing of a final Office Action. No item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 CFR. § 1.97(e)(2).

We are enclosing the required fee of \$180.00 set forth in 37 CFR §1.17(p). The Commissioner is hereby authorized to credit any overpayment and to charge any deficiency in any required fee to Deposit Account No. 19-3140. This sheet is being enclosed in duplicate.

Respectfully submitted,

date of signature:

Dec 18, 2008


Edward J. Radlo
Reg. No. 26,793
Attorney of Record

SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, Illinois 60606-1080
(415) 882-2402

enclosures

cc: IP/T docket CH (w/encl.)
G. Benton (w. just 1449)